



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/676,508

09/30/2003

Nicholas Shiftan

16222U-015510US

8563

66945

7590

04/16/2008

TOWNSEND AND TOWNSEND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

EXAMINER

PARIKH, HARSHAD R

ART UNIT

PAPER NUMBER

4176

MAIL DATE

DELIVERY MODE

04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/676,508	Applicant(s) SHIFTAN ET AL.	
	Examiner HARSHAD PARIKH	Art Unit 4176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-174 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-174 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20041102 and 20051128</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claim 114 is objected to because of the following informalities:

It appears that “of claim 26” (line 1) was intended to be --of claim 113--, which change will be assumed for purposes of further consideration of the claims as to the merits, hereinbelow. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-174 are rejected under 35 U.S.C. 102 (b) as being anticipated by Pitroda et al. (US 5,590,038).

1. Referring to claim 1, Pitroda discloses a system for managing electronic receipts, comprising:

a portable device (UETC 20: Fig 2) configured to store a plurality of electronic receipts corresponding to a plurality of transactions and allow one or more of the plurality of electronic receipts to be retrieved; and

a base device (Main Central Computer 26: Fig 2) configured to store one or more policies relating to generation and management of electronic receipts and generate an electronic receipt for a corresponding transaction using at least one of the one or more policies and forward the generated electronic receipt to the portable device for storage;

wherein which one of the one or more policies is used for generating the electronic receipt depends on the corresponding transaction (see, col. 7, lines 50-60).

2. Referring to claim 2, Pitroda discloses a system comprising a user device (PC 24: Fig 2) configured to communicate with the portable device to allow a user to manage the plurality of electronic receipts stored on the portable device.

3. Referring to claim 3, Pitroda discloses a system comprising a management server (Fig 2) configured to communicate with the user device and retrieve information relating to one or more of the plurality of electronic receipts stored on the portable device.

4. Referring to claim 4, Pitroda discloses a system comprising a management server (Fig 2) that interacts with one or more applications and communicates the retrieved information from the portable device to the one or more applications.

5. Referring to claim 5, Pitroda discloses a system comprising an administration system

(Fig 2) configured to provide at least one of the one or more policies; wherein the management server cooperates with the administration system to restore one or more of the plurality of electronic receipts.

6. Referring to claim 6, Pitroda discloses a system (CIU and PC: Fig 2) wherein the user device and the portable device cooperate with each other in an off-line manner to allow the user to manage the plurality of electronic receipts.

7. Referring to claim 7, Pitroda discloses a system (see, col. 7, lines 35-45) wherein information relating to one or more of the plurality of electronic receipts is stored in the user device; and

wherein the information relating to one or more of the plurality of electronic receipts is exported to one or more applications residing either within or without the user device.

8. Referring to claim 8, Pitroda discloses an administration system (see, col. 2, lines 60-65) configured to communicate with the base device and provide at least one of the one or more policies to the base device to allow the base device to generate electronic receipts accordingly.

9. Referring to claim 9, Pitroda discloses an administration system (see, col. 2, lines 60-

65) periodically updates at least one of the one or more policies and forwards one or more updated policies to the base device.

10. Referring to claim 10, Pitroda discloses a system (29: Fig 2) wherein the base device is further configured to store a copy of the electronic receipt generated by the base device in a local receipt storage.

11. Referring to claim 11, Pitroda discloses a system (see, col. 5, lines 25-40) wherein contents of the local receipt storage are periodically uploaded to the administration system.

12. Referring to claim 12, Pitroda discloses a system wherein the user is able to use the base device to restore an electronic receipt on the portable device by using contents of the local receipt storage.

The user can access the main central computer from UETC or PC using main central computer (25) at any time (Fig 2).

13. Referring to claim 13, Pitroda discloses a system (see, col. 5, lines 25-40) wherein contents of the local receipt storage are exported to one or more applications residing either within or without the base device.

14. Referring to claim 14, Pitroda discloses a system (29: Fig 2) wherein the base device is further configured to store historical activity information relating to the electronic receipt generated by the base device in a local receipt activity log.

15. Referring to claim 15, Pitroda discloses a system (Fig 2) wherein contents of the local receipt activity log are periodically uploaded to the administration system.

16. Referring to claim 16, Pitroda discloses a system (Fig 2) wherein the administration system is further configured to collect information from the base device.

17. Referring to claim 17, Pitroda discloses a system (29: Fig 2) wherein the information collected from the base device by the administration system is used for reporting purposes.

18. Referring to claim 18, Pitroda discloses a system (see, col. 2, lines 30-35) wherein the information collected from the base device by the administration system is used for fraud control.

19. Referring to claim 19, Pitroda discloses a system (29: Fig 2) wherein the information collected from the base device by the administration system is used for base device management.

20. Referring to claim 20, Pitroda discloses a system (see, col. 6, lines 45-50) wherein the administration system is further configured to generate and manage keys and security attributes to allow the base device to generate a secure electronic receipt.

21. Referring to claim 21, Pitroda discloses a system (see, col. 2, lines 45-50) wherein the portable device includes user information relating to the user of the portable device; and

wherein when the user wishes to conduct a transaction, the user information is forwarded by the portable device to the base device and used by the base device to generate a corresponding electronic receipt for the transaction.

22. Referring to claim 22, Pitroda discloses a system (see, abstract) wherein the portable device includes at least one of a smart card, a personal digital assistant, a cellular phone, a pager, a memory stick, a secure digital card, a dongle and a payment card.

Abstract says "UET card includes information storage elements, an input interface, a processor, a display and a communication interface".

23. Referring to claim 23, Pitroda discloses a system (see, abstract) wherein one or more of the plurality of electronic receipts stored on the portable device are protected

from unauthorized access.

24. Referring to claim 24, Pitroda discloses a system (see, col. 6, lines 15-40) wherein one or more of the plurality of electronic receipts stored on the portable device each has one or more associated access conditions.

25. Referring to claim 25, Pitroda discloses a system (27: Fig 2) wherein the one or more policies correspond to one or more service providers.

26. Referring to claim 26, Pitroda discloses a system (see, col. 6, lines 15-25) wherein the base device is assigned a unique identifier.

27. Referring to claim 27, Pitroda discloses a system (see, col. 6, lines 15-40) wherein information relating to the unique identifier is incorporated into the electronic receipt generated by the base device.

28. Referring to claim 28, Pitroda A discloses a system (see, col. 6, lines 15-40) wherein the base device uses information from the portable device and a service provider environment to generate the electronic receipt.

29. Referring to claim 29, Pitroda discloses a system (23: Fig 2) wherein the service

provider environment includes one or more peripheral devices including an electronic cash register.

30. Referring to claim 30, Pitroda discloses a system (26, 27, 29: Fig 2) wherein the base device is further configured to delete an electronic receipt from the portable device if the electronic receipt has become invalid or has been confirmed for deletion.

31. Referring to claim 31, Pitroda discloses a system (26, 27, 29: Fig 2) wherein the base device includes at least one of a point of sales device, an ATM, a kiosk, a personal computer and a telephone including a cellular phone.

32. Referring to claim 32, Pitroda discloses a system (24: Fig 2) wherein the user device is further configured to allow the user to display one or more of the plurality of electronic receipts stored on the portable device.

33. Referring to claim 33, Pitroda discloses a system (Fig 2) wherein the user device communicates with the management server via an open network.

34. Referring to claim 34, Pitroda discloses a system (Fig 2) wherein the user is able to exchange information between the user device and the portable device.

35. Referring to claim 35, Pitroda discloses a system (24: Fig 2, also see, col. 6, lines 65-68) wherein the user is able to delete one or more of the plurality of electronic receipts stored on the portable device using the user device. Deleting a document is a generic feature of any computer device.

36. Referring to claim 36, Pitroda discloses a system (see, col. 6, lines 65-68) wherein the user is able to transfer one or more of the plurality of electronic receipts stored on the portable device onto the user device.

37. Referring to claim 37, Pitroda discloses a system (see, col. 6, lines 65-68) wherein the user is further able to delete the one or more transferred electronic receipts from the user device which is a generic feature of any PC.

38. Referring to claim 38, Pitroda discloses a system (see, col. 6, lines 65-68) wherein the user is further able to download the previously transferred one or more electronic receipts from the user device to the portable device.

39. Referring to claim 39, Pitroda discloses a system (see, col. 6, lines 65-68) wherein the user is able to store a duplicate copy of one or more of the plurality of electronic receipts stored on the portable device onto the user device.

40. Referring to claim 40, Pitroda discloses a system (see, col. 6, lines 15-40) wherein the electronic receipt stored on the portable device allows a user to redeem a service or merchandise; and

wherein upon the user requesting redemption of the service or merchandise, the base device retrieves the electronic receipt from the portable device and directs the electronic receipt to be deleted from the portable device.

Redeem service is same as purchasing the service or merchandise at the point of sale.

41. Referring to claim 41, Pitroda discloses a system (see, col. 6, lines 15-40) wherein at least one of the plurality of electronic receipts is tamper-proof.

42. Referring to claim 42, Pitroda discloses a system (Timer and Memory Management: Fig 7) wherein at least one of the plurality of electronic receipts includes a validity period.

43. Referring to claim 43, Pitroda discloses a system (see, col. 6, lines 15-40) wherein at least one of the plurality of electronic receipts includes receipt status information.

44. Referring to claim 44, Pitroda discloses a system (see, col. 6, lines 15-40) wherein at least one of the plurality of electronic receipts includes transaction identifying information.

45. Referring to claim 45 , see the above discussion regarding claims 1, 2, 3, 5, and 8.

46. Referring to claim 46, see the above discussion regarding claim 21.

47. Referring to claim 47, see the above discussion regarding claim 22.

48. Referring to claim 48, see the above discussion regarding claim 23.

49. Referring to claim 49, see the above discussion regarding claim 24.

50. Referring to claim 50, see the above discussion regarding claim 2.

51. Referring to claim 51, see the above discussion regarding claim 8.

52. Referring to claim 52, see the above discussion regarding claim 9.

53. Referring to claim 53, see the above discussion regarding claim 10.

54. Referring to claim 54, see the above discussion regarding claim 11.

55. Referring to claim 55, see the above discussion regarding claim 12.

56. Referring to claim 56, see the above discussion regarding claim 13.

57. Referring to claim 57, see the above discussion regarding claim 14.

58. Referring to claim 58, see the above discussion regarding claim 15.

59. Referring to claim 59, see the above discussion regarding claim 26.

60. Referring to claim 60, see the above discussion regarding claim 27.

61. Referring to claim 61, see the above discussion regarding claim 28.

62. Referring to claim 62, see the above discussion regarding claim 29.

63. Referring to claim 63, see the above discussion regarding claim 30.

64. Referring to claim 64, see the above discussion regarding claim 31.

65. Referring to claim 65, see the above discussion regarding claim 32.

- 66. Referring to claim 66, see the above discussion regarding claim 33.
- 67. Referring to claim 67, see the above discussion regarding claim 34.
- 68. Referring to claim 68, see the above discussion regarding claim 35.
- 69. Referring to claim 69, see the above discussion regarding claim 36.
- 70. Referring to claim 70, see the above discussion regarding claim 37.
- 71. Referring to claim 71, see the above discussion regarding claim 38.
- 72. Referring to claim 72, see the above discussion regarding claim 39.
- 73. Referring to claim 73, see the above discussion regarding claim 4.
- 74. Referring to claim 74, see the above discussion regarding claim 40.
- 75. Referring to claim 75, see the above discussion regarding claim 6.
- 76. Referring to claim 76, see the above discussion regarding claim 7.
- 77. Referring to claim 77, see the above discussion regarding claim 5.
- 78. Referring to claim 78, see the above discussion regarding claim 41.
- 79. Referring to claim 79, see the above discussion regarding claim 42.
- 80. Referring to claim 80, see the above discussion regarding claim 43.
- 81. Referring to claim 81, see the above discussion regarding claim 44.
- 82. Referring to claim 82, see the above discussion regarding claim 16.
- 83. Referring to claim 83, see the above discussion regarding claim 17.
- 84. Referring to claim 84, see the above discussion regarding claim 18.
- 85. Referring to claim 85, see the above discussion regarding claim 19.
- 86. Referring to claim 86, see the above discussion regarding claim 20.

87. Referring to claim 87, see the above discussion regarding claim 1.
88. Referring to claim 88, see the above discussion regarding claim 1.
89. Referring to claim 89, see the above discussion regarding claim 2.
90. Referring to claim 90, see the above discussion regarding claim 3.
91. Referring to claim 91, see the above discussion regarding claim 5.
92. Referring to claim 92, see the above discussion regarding claim 4.
93. Referring to claim 93, see the above discussion regarding claim 6.
94. Referring to claim 94, see the above discussion regarding claim 7.
95. Referring to claim 95, see the above discussion regarding claim 8.
96. Referring to claim 96, see the above discussion regarding claim 9.
97. Referring to claim 97, see the above discussion regarding claim 10
98. Referring to claim 98, see the above discussion regarding claim 11
99. Referring to claim 99, see the above discussion regarding claim 12
100. Referring to claim 100, see the above discussion regarding claim 13.
101. Referring to claim 101, see the above discussion regarding claim 14.
102. Referring to claim 102, see the above discussion regarding claim 15.
103. Referring to claim 103, see the above discussion regarding claim 16.
104. Referring to claim 104, see the above discussion regarding claim 17.
105. Referring to claim 105, see the above discussion regarding claim 18.
106. Referring to claim 106, see the above discussion regarding claim 19.
107. Referring to claim 107, see the above discussion regarding claim 20

- 108. Referring to claim 108, see the above discussion regarding claim 21
- 109. Referring to claim 109, see the above discussion regarding claim 22
- 110. Referring to claim 110, see the above discussion regarding claim 23.
- 111. Referring to claim 111, see the above discussion regarding claim 24.
- 112. Referring to claim 112, see the above discussion regarding claim 25.
- 113. Referring to claim 113, see the above discussion regarding claim 26.
- 114. Referring to claim 114, see the above discussion regarding claim 27.
- 115. Referring to claim 115, see the above discussion regarding claim 28.
- 116. Referring to claim 116, see the above discussion regarding claim 29.
- 117. Referring to claim 117, see the above discussion regarding claim 30
- 118. Referring to claim 118, see the above discussion regarding claim 31
- 119. Referring to claim 119, see the above discussion regarding claim 32
- 120. Referring to claim 120, see the above discussion regarding claim 33.
- 121. Referring to claim 121, see the above discussion regarding claim 34.
- 122. Referring to claim 122, see the above discussion regarding claim 35.
- 123. Referring to claim 123, see the above discussion regarding claim 36.
- 124. Referring to claim 124, see the above discussion regarding claim 37.
- 125. Referring to claim 125, see the above discussion regarding claim 38.
- 126. Referring to claim 126, see the above discussion regarding claim 39.
- 127. Referring to claim 127, see the above discussion regarding claim 40
- 128. Referring to claim 128, see the above discussion regarding claim 41

- 129. Referring to claim 129, see the above discussion regarding claim 42
- 130. Referring to claim 130, see the above discussion regarding claim 43.
- 131. Referring to claim 131, see the above discussion regarding claim 44.
- 132. Referring to claim 132, see the above discussion regarding claim 1.
- 133. Referring to claim 133, see the above discussion regarding claim 2, 3.
- 134. Referring to claim 134, see the above discussion regarding claim 21.
- 135. Referring to claim 135, see the above discussion regarding claim 22.
- 136. Referring to claim 136, see the above discussion regarding claim 23.
- 137. Referring to claim 137, see the above discussion regarding claim 24
- 138. Referring to claim 138, see the above discussion regarding claim 25
- 139. Referring to claim 139, see the above discussion regarding claim 25.
- 140. Referring to claim 140, see the above discussion regarding claim 9
- 141. Referring to claim 141, see the above discussion regarding claim 10.
- 142. Referring to claim 142, see the above discussion regarding claim 11.
- 143. Referring to claim 143, see the above discussion regarding claim 12.
- 144. Referring to claim 144, see the above discussion regarding claim 13.
- 145. Referring to claim 145, see the above discussion regarding claim 14.
- 146. Referring to claim 146, see the above discussion regarding claim 15.
- 147. Referring to claim 147, see the above discussion regarding claim 26
- 148. Referring to claim 148, see the above discussion regarding claim 27
- 149. Referring to claim 149, see the above discussion regarding claim 28

150. Referring to claim 150, see the above discussion regarding claim 29.

151. Referring to claim 151, see the above discussion regarding claim 30.

152. Referring to claim 152, see the above discussion regarding claim 31.

153. Referring to claim 153, see the above discussion regarding claim 32.

154. Referring to claim 154, see the above discussion regarding claim 33.

155. Referring to claim 155, see the above discussion regarding claim 34.

156. Referring to claim 156, see the above discussion regarding claim 35.

157. Referring to claim 157, see the above discussion regarding claim 36

158. Referring to claim 158, see the above discussion regarding claim 37

159. Referring to claim 159, see the above discussion regarding claim 38

160. Referring to claim 160, see the above discussion regarding claim 39.

161. Referring to claim 161, see the above discussion regarding claim 4.

162. Referring to claim 162, see the above discussion regarding claim 40.

163. Referring to claim 163, see the above discussion regarding claim 6.

164. Referring to claim 164, see the above discussion regarding claim 7.

165. Referring to claim 165, see the above discussion regarding claim 5.

166. Referring to claim 166, see the above discussion regarding claim 41.

167. Referring to claim 167, see the above discussion regarding claim 42

168. Referring to claim 168, see the above discussion regarding claim 43

169. Referring to claim 169, see the above discussion regarding claim 14

170. Referring to claim 170, see the above discussion regarding claim 16.

171. Referring to claim 171, see the above discussion regarding claim 17.

172. Referring to claim 172, see the above discussion regarding claim 18.

173. Referring to claim 173, see the above discussion regarding claim 19.

174. Referring to claim 174, see the above discussion regarding claim 20.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent 5,590,038 to Satyan G. Pitroda discloses the Universal Electronic Transaction card including receipt generation, storage, and retrieval. It discusses a system to conduct electronic transactions.
- US Patent 6,327,576 to Nobuo Ogtasawara discloses a scheme for electronic receipts including shelf life limitations.
- US Patent 5,739,512 to Bruce Tognazzini discusses Digital delivery of receipts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARSHAD PARIKH whose telephone number is (571) 270-5468. The examiner can normally be reached on Monday through Thursday 9AM-5PM (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HRP/
April 1, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 4176